

Appl. No.: 09/990,570
Filed: November 21, 2001
Page 2

REMARKS/ARGUMENTS

Reexamination and reconsideration of this Application, withdrawal of the rejection, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks that follow. Claims 1-24 are pending in the application.

It is noted that an initialed copy of the PTO Form 1449 that was submitted with Applicants' Information Disclosure Statement filed November 21, 2001, has not been returned to Applicants' representative with the Office Action. Accordingly, it is requested that an initialed copy of the Form 1449 be forwarded to the undersigned with the next communication from the PTO. In order to facilitate review of the reference by the Examiner, a copy of the Information Disclosure Statement and the Form 1449 are attached hereto. A copy of the cited reference was provided at the time of filing of the original Information Disclosure Statement and, therefore, no additional copy is submitted herewith. Applicants will be pleased to provide an additional copy of the reference upon the Examiner's request.

The Examiner has requested that Applicants provide an Information Disclosure Statement listing all the references cited in the parent patent. In response, Applicants enclose herewith an Information Disclosure Statement citing all documents made of record in the parent patent.

Claims 1-24 stand rejected under 35 U.S.C. §251 as being drawn to subject matter that is subject to the recapture rule. The Examiner alleges that herbicidal combinations of dimethenamid and a triazine represent subject matter that was deliberately cancelled in order to overcome a rejection in a parent application. In support of this contention, the Examiner provides a brief history of several applications preceding the present reissue application. Applicants respectfully traverse this rejection.

Applicants submit that the Examiner has erroneously relied upon applications preceding the application that resulted in the patent to be reissued in reaching the conclusion that the recapture rule has been violated. Applicants respectfully submit that the only application that is relevant in a recapture rule analysis is the original application that resulted in the issuance of the

Appl. No.: 09/990,570
Filed: November 21, 2001
Page 3

patent that is the subject of the present reissue application. In other words, only the claims and arguments presented during prosecution of Application Serial No. 08/911,926 are relevant with respect to the recapture analysis.

In §1412.02, the MPEP states that a reissue will not be granted to recapture subject matter surrendered "in an application to obtain the original patent." The same section of the MPEP goes further to note that the recapture analysis involves determining whether the broader aspects of the reissued claim relate to subject matter that "applicant previously surrendered during the prosecution of the original application (which became the patent to be issued)." Still further, the same section of the MPEP notes that the Examiner "should review the prosecution history of the original application file (of the patent to be reissued) for recapture." The case law is consistent with this interpretation of the recapture rule section of the MPEP. In *Hester Industries Inc. v. Stein Inc.*, the court stated, "surrender can occur by way of arguments or claim changes made during the prosecution of the *original patent application*." 46 USPQ2d 1641, 1648 (Fed. Cir. 1998) (emphasis added). In light of the foregoing, it is clear that the only application that is relevant to a recapture analysis is the application that resulted in the original patent that is the subject of the reissue application. There is nothing in the MPEP that authorizes study of prior applications in the chain of applications that ultimately resulted in the patent. Instead, the only relevant analysis involves comparison of the prosecution history of the original application resulting in the patent and the claims of the reissue application.

Under this reasonable interpretation of the recapture section of the MPEP, Applicants respectfully submit that the recapture rejection cannot stand. Applicants did not expressly claim combinations of dimethenamid and triazine herbicides at any time during prosecution of Application Serial No. 08/911,926. Instead, the '926 application was originally filed with claims directed to 1) a method of controlling undesired plant growth using a combination of dimethenamid and a triketone or dione herbicide and 2) a herbicidal composition comprising a triketone or dione herbicide in combination with dimethenamid (see Preliminary Amendment filed concurrently with the '926 application).

Applicants note that, although the original application contained claims that recited a combination of dimethenamid and at least one other herbicide, those claims were cancelled and

Appl. No.: 09/990,570
Filed: November 21, 2001
Page 4

replaced with the claims described above in a Preliminary Amendment filed concurrently with the application. Since there was no intervening rejection of the original claims that preceded the Preliminary Amendment, there is no basis for asserting that the amendment of the claims in the Preliminary Amendment was made for reasons related to patentability. The courts have squarely addressed this issue and determined that there is no intent to surrender subject matter where the applicant cancels and replaces a claim without intervening action by the Examiner. See *In re Willingham*, 127 USPQ 211 (CCPA 1960). In *Willingham*, a claim was entered by a supplemental amendment and thereafter deleted and replaced with another claim by a second supplemental amendment. No action by the Examiner intervened between the amendments. Thus, as the court noted, the deleted claim was "never rejected or otherwise acted on." *Id.* at 213. The court held that "the reasons for the deletion of Claim 12 of the original application do not appear of record, and we may not properly speculate as to what they may have been and base our decision on the result of such speculation." *Id.* at 215. The court went further to note that "the appealed claims differ materially from cancelled Claim 12 and there is nothing of record on which to base a holding that the cancellation of Claim 12 was in any sense an admission that the reissue claims on appeal were not in fact patentable to appellant at the time Claim 12 was deleted." *Id.* at 215-216. The fact pattern confronted by the court in *Willingham* is factually similar to the situation wherein a preliminary amendment filed concurrently with an application cancels the original claims and adds new claims. In that situation, there is also no intervening action by the Examiner and nothing in the record to indicate that the Applicants were consciously and deliberately forfeiting subject matter in response to a rejection. In fact, there is obviously no rejection of record at all.

During prosecution of the '926 application, no substantive amendments were made to the types of herbicides recited in the independent claims. Thus, Applicants did not claim combinations of dimethenamid and triazine herbicides at any point during prosecution of the '926 application. It necessarily follows that none of the arguments made by Applicant during the prosecution of the '926 application made reference to combinations of dimethenamid and triazine herbicides. Applicants respectfully submit that the prosecution history of the '926 application provides no basis for the Examiner's allegation that a combination of dimethenamid

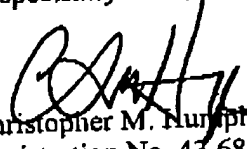
Appl. No.: 09/990,570
Filed: November 21, 2001
Page 5

and a triazine herbicide is subject matter that runs afoul of the recapture rule. As a result, Applicants respectfully submit reconsideration and withdrawal of this rejection.

It is believed that all pending claims are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned should the Examiner have any comments or suggestions in order to expedite examination of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

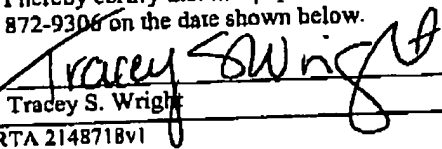
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 872-9306 on the date shown below.


Tracey S. Wright

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Date